

REMARKS

Reconsideration of the application is requested in view of the modifications above and the remarks below. Claims 24, 26-29 and 42 have been amended and claims 22-23 have been canceled. Claims 26-29 and 42 have been amended to dependent from claim 24.

Rejections Under 35 USC 112, second paragraph

The Office Action rejected Claims 22, 26-29 and 42-43 as indefinite. Independent Claim 22 has been cancelled. Claims 26-29 and 42-43 have been amended and depend directly or indirectly from Claim 24. Reconsideration is requested.

Rejections Under 35 USC 102

1. Rejection Under U.S.C. 35 USC §102 as anticipated by JP 10-021,901 (Watada et al.).

The Office Action rejected Claims 22-25, 27-29 and 42-43 under 35 USC 102 as anticipated by Watada et al. The rejection should be withdrawn in view of the modifications above and the remarks below.

It is well settled that in order for a prior art reference to anticipate a claim, the reference must disclose each and every element of a claim with sufficient clarity to prove its existence in prior art. The disclosure requirement under 35 USC 102 presupposes knowledge of one skilled in art of a claimed invention, but such presumed knowledge does not grant license to read into prior art reference teachings that are not there. See Motorola Inc. v. Interdigital Technology Corp. 43 USPQ2d 1481 (1997 CAFC).

Amended Claim 24 is directed to a cobalt hydroxide coating including the nickel hydroxide stable to oxidation, and the coating has 1 to 200 mmol of one or more anions of weak inorganic oxygen acids per mol of cobalt(II) hydroxide. Further, claim 24 has been amended to include "on the surface of the cobalt hydroxide coating is at most a monomolecular layer of said anions of the weak inorganic oxygen acids." Support for the amendment to claim 24 is found in the

Specification at page 4, line 29 to page 5, line 2 and in the figures.

In Applicants' Claim 24, the anions are contained in a thin layer in the outermost shell of the cobalt hydroxide coating. The nickel hydroxide, according to Applicants' invention, is distinguished not only by the fact that the concentration of the anions on the surface of the cobalt hydroxide coating is very high, thereby producing excellent oxidation stability, but also by the fact that the total concentration of the anion in the cobalt hydroxide coating is comparatively small. This is advantageous for the use of the coated nickel hydroxides in batteries, because, for example, the presence of carbonate can result in the carbonation of the electrolyte in the battery (usually 6-8 molar KOH). There is also the danger that K₂CO₃ crystals precipitate out and damage the battery.

Watada et al. discloses a nickel hydroxide having a cobalt hydroxide coating that additionally contains a doping element A and an anion B. The production of the cobalt hydroxide coating is carried out by precipitating a cobalt salt containing anions in the presence of a salt A-B (see Abstract). Thus, the anion B is dispersed in the cobalt hydroxide coating and not formed on the surface as a layer. Therefore, Watada et al. does not provide any suggestion that the coating has 1 to 200 mmol of one or more anions of weak inorganic oxygen acids per mol of cobalt(II) hydroxide, and wherein on the surface of the cobalt hydroxide coating is at most a monomolecular layer of said anions of the weak inorganic oxygen acids of Applicants' Claim 24.

Accordingly, Watada et al. does not disclose each and every element of a claim with sufficient clarity to prove Applicants' invention existed in the prior art. Reconsideration is requested.

Regarding Claim 29, Claim 29 depends from independent Claim 24, which as discussed is believed to be allowable. Thus, Claim 29 which depends from Claim 24 also is believed to be allowable. Reconsideration is requested.

Accordingly, in view of the remarks and amendment above, Claim 29 is believed to be allowable. Reconsideration is requested

Rejections Under 35 USC 103

Rejection of Claim 26 Under 35 USC §103(a) as unpatentable over over JP 10-021,901 (Watada et al.) in view of U.S. Patent No. 6,007, 946 (Yano et al.)

Claim 26 stands rejected under 35 USC §103(a) as unpatentable over over JP 10-021,901 (Watada et al.) in view of U.S. Patent No. 6,007, 946 (Yano et al.). The rejection should be withdrawn in view of the remarks below.

It is well established that to establish a *prima facie* case of obviousness, the USPTO must satisfy all of the following requirements. First, the prior art relied upon, coupled with the knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or to combine references. *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Second, the proposed modification must have had a reasonable expectation of success, as determined from the vantage point of one of ordinary skill in the art at the time the invention was made. *Amgen v. Chugai Pharmaceutical Co.* 18 USPQ 2d 1016, 1023 (Fed Cir, 1991), cert. denied 502 U.S. 856 (1991). Third, the prior art reference or combination of references must teach or suggest all of the limitations of the claims. *In re Wilson*, 165 USPQ 494, 496, (CCPA 1970).

Dependent Claim 26 is directed to the coated nickel hydroxide of Claim 24, wherein the nickel hydroxide is in the form of powder and the nickel hydroxide has an average particle size (D50 value, measured by the Mastersizer method) of 0.5 to 500 μm . As discussed, Claim 24 is believed to be allowable, thus Claim 26 which depends from Claim 24 also is believed to be allowable. Reconsideration is requested.

Further, Yano et al. does not teach or suggest any surface modified with anions of a weak, inorganic oxygen acid. One of ordinary skill in the art following the teachings of Yano et al would not have been motivated to modify the invention taught by the Watada et al. Thus, neither Watada et al. nor Yano et al., either alone or in combination have rendered obvious, the Applicants' invention of Claim 26.

In view of the foregoing amendments and remarks, allowance of the pending claims is earnestly requested.

Respectfully submitted,

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